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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/677,577 | 10/03/2000 | Iwao Masuyama | 723-939 | 5668 |

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| EXAMINER |
|---|
| WHITE, CARMEN D |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3714 | |

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/677,577 | Applicant(s) MASUYAMA ET AL. | |
|---|---|---|---|
| | Examiner Carmen D. White | Art Unit 3714 | |

-- Th MAILING DATE of this communication app ars on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 January 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) *15-21 and 36-42* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14 and 22-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *8* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

***Election***

Applicant's election without traverse of claims 1-14 and 22-35 in Paper No. 10 is acknowledged.

***Specification***

The substitute specification filed February 6, 2001 has not been entered because it does not conform to 37 CFR 1.125(b)(1), which states the following:

(b) A substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by:

**(1) A statement that the substitute specification includes no new matter.**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(please see attachment for the requirements of 102(e), which includes the recent changes)

Claims 1, 6, 9, 11-14, 22, 27, 30, 32-35 are rejected under 35 U.S.C. 102(e) as being anticipated by ***Rudell*** et al (6,200,219).

Regarding claims 1, 6, 9, 11-14, 22, 27, 30, 32-35, Rudell teaches a gaming system that has a game apparatus having game program storage means storing a game program, and processing means for executing the game program, and display means to display an image based on the result of processing by the processing means that comprises a housing to be held by a player; and a change-state detecting means

related to the housing for detecting at least one of an amount and a direction of a change applied to the housing, wherein the game program storage means game space data including image data to display a space for game play, and a display control program causes said display means to display a game space based on the game space data; and a simulation program provides simulation based on an output of said change-state detecting means such that a state of the game space is changed related to at least a change amount and a change direction applied to said housing (abstract; Fig. 1 and Fig. 6).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell et al.

Rudell teaches all the limitations of the claim as discussed above. Rudell is silent regarding the feature of storage of non-player character data. However, the memory of Rudell is functionally capable of storing such information, depending on the type of game being played on Rudell. It would have been obvious to a person of ordinary skill in the art to enhance Rudell for non-player data storage to allow two player

game play. This would increase the competitive nature of the game and thereby increase player participation.

Claims 2-5, 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell et al in view of Mical et al (4,969,647).

Rudell teaches all the limitations of the claims as discussed above. Rudell lacks teaching the tilting of the apparatus to change game play functions. In an analogous hand-held gaming device, Mical teaches this feature (abstract; Fig. 2 and 3). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature as taught by Mical in Rudell to make the game more exciting for the player and more versatile.

Claim 7-8, 28-29 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell et al in view of Saito (5,926,438).

Rudell teaches all the limitations of the claims as discussed above. Rudell is silent regarding the teaching of the feature of a cartridge. In an analogous hand-held gaming apparatus, Saito teaches this feature (Fig. 1). It would have been obvious to a person of ordinary skill in the art at the time of the feature to include this feature, as taught by Saito, in Rudell in order to allow the player the convenience of playing different games on different cartridges.

***USPTO Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for ***Non-Official*** communications and 703-305-3579 for ***Official*** communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

C. White
Patent Examiner

# Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.